UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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ART UNIT	PAPER NUMBER
3622	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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	Application No.	Applicant(s)
Office Action Summary	10/595,998	BAE ET AL.
	Examiner	Art Unit	
	NATHAN C. UBER	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>22 September 2008</u>.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-16 and 18</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-16 and 18</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☒ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Status of Claims

1.   This action is in reply to the amendment filed on 22 September 2008.

2.   Claims 1-6, 12, 13, 15 and 16 have been amended.

3.   Claim 18 has been added.

4.   Claim 17 has been canceled.

5.   Claims 1-16 and 18 are currently pending and have been examined.

Claim Rejections - 35 USC § 112

6.   Claim 5 was rejected under 35 U.S.C. 112, second paragraph, because claim 5 contained limitations directed to more than one statutory category. Applicant has adequately addressed this rejection by amendment. The rejection is withdrawn.

7.   Claims 4, 5 and 16 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitations *upper concept* and *lower concept* were used to limit *expansion keyword*. Although the limitation *expansion keyword* is known and understood in the art, the meaning of an *upper* and *lower concept* of an *expansion keyword* is not known in the art and an explanation was absent from the specification. Applicant's amendment to claims 4, 5 and 16 removed the indefinite terms from the claims rendering this rejection with respect to claims 4, 5 and 16 moot.

8.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9.   Claims 4, 5 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in

the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicant added the limitation *the expansion keyword is in genus-species hierarchies with the keyword* to claims 4, 5 and 16. Applicant argues that ¶0100 of the specification and figure 13 provides support for this new limitation. Examiner disagrees, neither the cited paragraph nor figure 13 disclose or illustrate a genus-species hierarchy relationship among keywords. Since Applicant's original disclosure does not teach a genus-species hierarchy among keywords, the limitation is considered new matter and the claims are therefore rejected under U.S.C. § 112 first paragraph.

10.   Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicant amended the claims to overcome a U.S.C. 101 rejection by adding two structural limitations so that the claims no longer lacked structural features. The new limitations *a processor* and *one or more memories* are not supported by the original specification. Therefore these new limitations are considered new matter and claims 1-5 are rejected under U.S.C. § 112.

11.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12.   Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 18 is directed to *one or more computer-readable media having stored thereon a computer program that, when executed by one or more processors...* The claim is indefinite because it is not known in the art nor clear from the disclosure how *one program* is simultaneously stored on multiple computer-readable media and simultaneously executable by multiple processors. For example it is well known in the art that a program may be stored on

multiple disks, but such programs are not executable until downloaded/installed so that the entire program is present on one medium. Further programs are usually only executable by one processor at a time; it is therefore unclear how multiple processors may execute the single program. Examiner notes that Applicant asserted that the indefinite language above is "in accordance with Examiner's suggestions" (see pp 15 of Applicant's amendment) however, this language is <u>not</u> in accordance with Examiner's suggestions in the previous Office action. Examiner previously suggested that "'<u>a</u> computer-executable program product tangibly embodied on <u>a</u> computer readable medium' is statutory subject matter" (see ¶10).

Claim Rejections - 35 USC § 101

13.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

14.   Claims 1-11 were rejected under 35 U.S.C. 101 because the claimed invention was directed to non-statutory subject matter. The claims are directed to a system; however the body of the claims did not disclose any structure. Applicant amended the claims to recite a *processor* and *one or more memories*. This rejection is withdrawn because the claims are now directed to structural features. However, Examiner maintains that the remaining limitations of the claims (modules, databases, control units, and data) are not structural components and are further not statutory subject matter under U.S.C. § 101.

15.   Claims 12-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v.* Diehr, 450 U.S. 175, 184 (1981); *Parker v.* Flook, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v.* Benson, 409 U.S. 63, 70 (1972); *Cochrane v.* Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v.* Benson, 409 U.S. 63, 71 (1972)). A method/process claim that

fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claim 12 fails to meet the above requirements because it is not tied to a second statutory class and it does not transform underlying subject matter. The last limitation of claim 12 claims *controlling the adopted advertisement data* and further defines the *advertisement data* of the claim as the data *to be displayed on the user terminal.* Although the *user terminal* is a second statutory class of invention, here it is not sufficiently tied to the claim because it comprises merely non-functional descriptive material in the claim. Further the act of displaying a result in a method is considered "insignificant post solution activity" (see *In re Bilski,* CAFC, decided 30 October 2008). Claims 13-16 inherit the deficiencies of claim 12, and because they do not tie in a second statutory class they are also not statutory under 35 U.S.C. §101. This rejection is maintained in the present Office action. Applicant attempted to address this rejection by changing the preamble of the claim; however, the preamble does not garner patentable weight in this claim because it is not tied to the limitations in the body of the claim.

16.   Claim 17 was rejected under 35 U.S.C. 101 because the claimed invention was directed to non-statutory subject matter. Claim 17 was canceled, so the rejection is moot.

17.   Claim 5 was rejected under 35 U.S.C. 101 because the claim was directed two different statutory classes of invention. Applicant amended this claim to overcome this rejection. The rejection is withdrawn.

Claim Rejections - 35 USC § 102

18.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application

filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

19.   **Examiner's Note**: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

20.   Claims 1-7, 9, 12-13 and 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Dean et al. (U.S. 2004/0059708 A1).

Claim 1:

Dean, as shown, discloses the following limitations:

- *a processor* (see at least figure 3, item 308),

- *one or more memories to communicate with the processor, the one or more memories storing database* (see at least figure 3, item 309),

- *an advertisement database for maintaining advertisement data of a plurality of advertisements, at least one keyword related to each said advertisement and a category corresponding to each said advertisement* (see at least Figure 2, Item 240),

- *a content database for maintaining a content identifier for identifying content provided to a user terminal though a communication network, and a category related to the content* (see at least Figure 2, Item 240),

- *an advertisement data searching unit configured for searching the advertisement database for advertisement data corresponding to the maintained category related to the content to be displayed to a user* (see at least Figure 2, Item 260),

- *an advertisement data selecting unit configured for selecting a portion of advertisement data among the searched advertisement data, based on a predetermined criterion, by using a keyword related to the searched advertisement data* (see at least Figure 2, Item 260),

- *a display control unit configured for controlling an advertisement associated with the selected advertisement data to be displayed on the user terminal in association with the content* (see at least Figure 2, Item 280).

Claim 2:

Dean, as shown, discloses the following limitations:

- *the advertisement data selecting unit comprises a keyword searching module, resident in one of the memories and executable by the processor, configured for searching the content to be displayed to the user for the at least one keyword related to the searched advertisement data* (see at least ¶0044, analyzing the target document, see also ¶0043 the targeting information may be a keyword, see also ¶0042 the operations described in ¶¶0043+ describe the function that occurs in the ad selection unit Figure 2, Item 260),

- *an exposure point computing module, resident in one of the memories and executable by the processor, configured for computing an exposure point for the search advertisement data by using at least one of three factors comprising a number of the searched keywords in the content, positions of the searched keyword in the content and a font style of the searched keywords* (see at least ¶0048, greater frequency of targeted terms),

- *an advertisement data selecting module, resident in one of the memories and executable by the processor, configured for selecting a portion of advertisement data among the searched advertisement data, based on the exposure point* (see at least ¶0033, ads received from the ad selection unit

are ordered by relevance based "on a value indication associated with each

ad").

Claim 7:

Dean, as shown, discloses the following limitation:

- *the advertisement data selecting module selects the predetermined number*

  of advertisement data of which the exposure point ranks high (see at least

  ¶0033, a list of ads are received from the ad selection unit and are ordered

  by relevance based "on a value indication associated with each ad").

Claim 9:

Dean, as shown, discloses the following limitation:

- *the advertisement data selecting module sequentially selects a*

  predetermined number of the selected advertisement data during the

  predetermined period (see at least ¶0033, a list of ads are received from the

  ad selection unit and are ordered by relevance based "on a value indication

  associated with each ad", here Examiner broadly interprets *predetermined*

  period based on the specification to mean an arbitrary amount of time

  including at least the amount processing time required to complete the

  method).

Claim 3:

Dean, as shown, discloses the following limitations:

- *keyword database for maintaining a keyword and a similar keyword related*

  thereto, wherein the similar keyword is a keyword having a similar meaning

  to the meaning of the keyword (see at least Figure 2, Item 240),

- *wherein the advertisement data selecting unit comprises a keyword*

  searching module, resident in one of the memories and executable by the

  processor, configured for searching the content for at least one keyword

  related to the searched advertisement data and a similar keyword to the at

least one keyword (see at least ¶0043 the targeting information may be a keyword. Examiner notes that this claim is directed only to a module, the intended use of the module does not carry any patentable weight. Nevertheless ¶0043 discloses the intended use of the claimed module),

- *an exposure point computing module, resident in one of the memories and executable by the processor, configured for computing an exposure point for the search advertisement data by using at least one of three factors comprising a number of the searched keywords in the content, positions of the searched keyword in the content and a font style of the searched keywords* (see at least ¶0048, greater frequency of targeted terms),

- *an advertisement data selecting module, resident in one of the memories and executable by the processor, configured for selecting a portion of advertisement data from the searched advertisement data, based on the exposure point* (see at least ¶0033, ads received from the ad selection unit are ordered by relevance based "on a value indication associated with each ad").

Claim 4:

Dean, as shown, discloses the following limitations:

- *a keyword database for maintaining a keyword and an expansion keyword related thereto, wherein the expansion keyword and the keyword are in genus-species hierarchies* (see at least Figure 2, Item 240),

- *wherein the advertisement data selecting unit comprises a keyword searching module resident in one of the memories and executable by the processor, configured for searching the content for a keyword related to the searched advertisement data and an expansion keyword related to the keyword* (see at least ¶0043 the targeting information may be a keyword. Examiner notes that this claim is directed only to a module, the intended use

of the module does not carry any patentable weight. Nevertheless ¶0043 discloses the intended use of the claimed module),

- *an exposure point computing module, resident in one of the memories and executable by the processor, configured for computing an exposure point for the search advertisement data by using at least one of three factors comprising a number of the searched keywords in the content, positions of the searched keyword in the content and a font style of the searched keywords* (see at least ¶0048, greater frequency of targeted terms),

- *an advertisement data selecting module, resident in one of the memories and executable by the processor, configured for selecting a portion of advertisement data from the searched advertisement data, based on the exposure point* (see at least ¶0033, ads received from the ad selection unit are ordered by relevance based "on a value indication associated with each ad").

Claim 5:

Dean, as shown, discloses the following limitations:

- *keyword database for maintaining a keyword, a similar keyword related thereto and an expansion keyword related thereto, wherein the similar keyword is a keyword having a similar meaning to the meaning of the keyword and the expansion keyword is in genus-species hierarchies with the keyword* (see at least Figure 2, Item 240),

- *wherein the advertisement data selecting unit comprises a keyword searching module, resident in one of the memories and executable by the processor, configured for searching the content for a keyword related to the searched advertisement data, a similar keyword related to the keyword and an expansion keyword related thereto keyword* (see at least ¶0043 the targeting information may be a keyword),

- *an exposure point computing module, resident in one of the memories and executable by the processor, configured for computing an exposure point for the search advertisement data by using at least one of three factors comprising a number of the searched keywords in the content, positions of the searched keyword in the content and a font style of the searched keywords* (see at least ¶0048, greater frequency of targeted terms),

- *for computing a second exposure point for the search advertisement data by using at least one of three factors comprising a number of the searched keywords in the content, positions of the searched keyword in the content and a font style of the searched keywords* (see at least ¶0048, greater frequency of targeted terms),

- *for computing a third exposure point for the search advertisement data by using at least one of three factors comprising a number of the searched keywords in the content, positions of the searched keyword in the content and a font style of the searched keywords* (see at least ¶0048, greater frequency of targeted terms),

- *computing an exposure point based on at least one of the first exposure point, the second exposure point and the third exposure point* (see at least ¶0048, documents with greater frequency of targeted terms get greater weight),

- *an advertisement data selecting module, resident in one of the memories and executable by the processor, configured for selecting a portion of advertisement data from the searched advertisement data, based on the exposure point* (see at least ¶0033, ads received from the ad selection unit are ordered by relevance based "on a value indication associated with each ad"),

With regard to analyzing advertisements multiple times and calculating multiple *exposure points*, Dean discloses "additionally or alternatively" analyzing multiple words in one document (see at least ¶0048) as well as analyzing meta data (see at least ¶0051).

Claim 6:

Dean, as shown, discloses the following limitation:

- *the exposure point computing module computes the exposure point by applying a weight value to the first exposure point, the second exposure point or the third exposure point* (see at least ¶0051, different value measures/weights may be used "alternatively or in addition" to each other).

Claims 12 and 18:

Dean, as shown, discloses the following limitations:

- *maintaining advertisement data, at least one keyword related to the advertisement data and a category corresponding to the advertisement data, in an advertisement database* (see at least ¶0030, ad data stored in databases),

- *maintaining a content identifier for identifying content provided to a user terminal through a communication network and a category related to the content, in a content database* (see at least ¶0030, content provided to a user is stored in databases),

- *searching the advertisement database for advertisement data corresponding to a category related to the content to be displayed to a user* (see at least ¶0032, ad selection component),

- *selecting advertisement data among the searched advertisement data, based on a predetermined criterion, by using at least one keyword related to the searched advertisement data* (see at least ¶0033, ad ordering component),

- *controlling an advertisement associated with the selected advertisement data to be displayed on the user terminal in association with the content* (see at least ¶0034, ad serving component).

Claim 13:

Dean, as shown, discloses the following limitations:

- *maintaining the advertisement database comprises the steps of: receiving a keyword and advertisement data from an advertiser* (see at least ¶0027, ad entry management component),

- *receiving selection of a category for the advertisement data from the advertiser* (see at least ¶0027, ad entry management component),

- *storing the received keyword and the category in association with the advertisement database* (see at least ¶0030, ad data stored in databases).

Claim 15:

Dean, as shown, discloses the following limitations:

- *maintaining keywords in a keyword database* (see at least ¶0030, ad data stored in databases),

- *wherein the step of selecting advertisement data according to a predetermined criterion from the searched advertisement data by using the keyword comprises the steps of respectively searching the content for a keyword related to the advertisement data* (see at least ¶0043, identifying documents by keyword),

- *for computing an exposure point for the search advertisement data by using at least one of three factors comprising a number of the searched keywords in the content, positions of the searched keyword in the content and a font style of the searched keywords* (see at least ¶0048, greater frequency of targeted terms),

- *selecting advertisement data from the searched advertisement data based on the exposure point* (see at least ¶0033, ad ordering component).

Claim 16:

Dean, as shown, discloses the following limitations:

- *maintaining a keyword, a similar keyword related thereto or an expansion keyword related thereto in a keyword database, wherein the similar keyword is a keyword having a similar meaning to the meaning of the keyword and the expansion keyword is in genus-species hierarchies with the keyword* (see at least ¶0030, ad data stored in databases),

- *wherein the step of selecting advertisement data according to a predetermined criterion from the searched advertisement data using the keyword comprises the steps of respectively searching the content for a keyword related to the advertisement data* (see at least ¶0043 the targeting information may be a keyword),

- *searching for a similar keyword related to the searched keyword or an expansion keyword related thereto* (see at least ¶0043, using keywords and similar keywords),

- *computing a first exposure point for the search advertisement data by using at least one of three factors comprising a number of the searched keywords in the content, positions of the searched keyword in the content and a font style of the searched keywords* (see at least ¶0048, greater frequency of targeted terms),

- *computing a second exposure point for the search advertisement data by using at least one of three factors comprising a number of the searched keywords in the content, positions of the searched keyword in the content and a font style of the searched keywords* (see at least ¶0048, greater frequency of targeted terms),

- *computing an exposure point from the searched advertisement data, based on the first exposure point or the second exposure point* (see at least ¶0048, documents with greater frequency of targeted terms get greater weight).

Claim Rejections - 35 USC § 103

21.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

22.   The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1.   Determining the scope and contents of the prior art.
2.   Ascertaining the differences between the prior art and the claims at issue.
3.   Resolving the level of ordinary skill in the pertinent art.
4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

23.   Claims 8 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dean et al. (U.S. 2004/0059708 A1).

Claims 8 and 10-11:

Dean, as shown, discloses the following limitations:

- *the advertisement data selecting module selects predetermined advertisement data from the searched advertisement data on the basis of the exposure point and* (see at least ¶0033, a list of ads are received from the ad selection unit and are ordered by relevance based "on a value indication associated with each ad"),

- *selects a predetermined number of random advertisement data, during a predetermined period, from the selected advertisement data* (see at least ¶0033, a list of ads are received from the ad selection unit and "may be ordered based on the value indication")

Dean does not specifically disclose that the ordering may be random. However, there are only a finite number of ways to order a predetermined list of advertisements for presentation to a user (including in order of relevancy, based on the rate paid for the ad, randomly, etc.) Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to try a different criteria for ordering the advertisements for presentation to the user (such as random ordering/selection) since there are a finite number of identified, predictable potential solutions and one having ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success.

24.   Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dean et al. (U.S. 2004/0059708 A1) in view of Anick et al. (U.S. 6,778,975 B1).

Claim 14:

Dean discloses the limitations as shown in the rejections above. Dean further discloses determining relevant advertisement and content topics, however Dean does not specifically disclose categories as in the limitations below. Anick, as shown, discloses the following limitations:

- *receiving selection of a category from the advertiser comprises the steps of maintaining categories in a predetermined database* (see at least column 6, lines 54-55, advertisers specify categories for their ad submissions),
- *providing the categories for the advertiser by a directory searching method* (see at least column 5, line 17-27, the categories are predetermined),

- receiving selection of a predetermined category among the provided categories, from the advertiser (see at least column 6, lines 54-55, advertisers specify categories for their ad submissions),

It would have been obvious to one having ordinary skill in the art at the time of the invention to additionally determine advertising relevancy to content using a category organization method since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Arguments

25.   Applicant's arguments filed 22 September 2008 have been fully considered but they are not persuasive. With respect to claims 1 and 12, Applicant asserts that Dean does not disclose "(1) a content database for maintaining a category related to the content" (see page 21 of Applicant's amendment, see also the mirror arguments for independent method claim 12 at page 22). Applicant supports this assertion by arguing that "Dean et al. does not store a category related to the content of the target page" rather "Dean analyzes the content of a target document to identify 'topics' for the target document" and further that "[t]he 'topics' of the content disclosed in the Dean et al. reference is distinct from the 'category' of the content in the present application" (pages 19 and 23 of Applicant's amendment). For support of this contention, Applicant relies on a single narrow dictionary definition for each of the words 'topic' and 'category.'

26.   As shown in the rejection above, Dean discloses a database (see figure 2, item 240). It is inherent that databases store data and Dean further discloses that "[d]atabases contain a variety of data used by advertising system" (¶0030). Applicant's claims are directed to specific databases that are distinguishable from each other merely by virtue of the type of data they store. However the type of data stored within a database constitutes non-functional descriptive material that does not receive patentable weight. The scope of the invention is not affected if the type of the data

stored in a database changes. Although Dean discloses all of the limitations of Applicant's claims as shown above (as is further detailed below), the fact that Dean discloses a generic database that stores any type of data sufficiently teaches Applicant's claim limitations directed to various databases and the various data stored therein. See MPEP 2106 for further information about non-functional descriptive material and why it does not receive patentable weight.

27.   Further Dean specifically discloses that the databases store "advertising creatives (simply referred to as 'ads' or 'advertisements'), one or more set of keywords or topics associated with those creatives (which may be used as targeting information for the ads), geographic targeting information, a value indication for the advertisement, start date, end date, etc" (¶0027). Examiner notes that the "content" of the advertisements is stored in the database and therefore the database of Dean may be considered a "content database" as in Applicant's claim. Further Dean's databases also store "target document[s]" (¶0044), Examiner notes that Examiner interpreted "target documents" to be equivalent to the "content" of Applicant's invention, but the term 'content' is broad and is not limited to 'target document[s].' Further both the "content of the advertisement" (¶0043) and the "target document" (¶0044) are analyzed to determine relevant "topics." Dean also discloses that the statistics engine "log[s] the information provided by the ad consumer" (¶0035) and that the "target document" may be the information "provided by the ad consumer" (¶0044). The "topic[s]" of Dean are employed in the same manner as the *content identifiers* of Applicant's invention, the "topic[s]" are derived from the advertisements and the target documents themselves. Contrary to Applicant's arguments cited above, Dean also discloses an alternative or additional method of identifying topics within target documents including employing <u>categories</u> (see ¶0053). Applicant assumed that Examiner equated topics with categories, but this is not necessarily the case. However, Examiner maintains that it would be appropriate to interpret Dean's liberal use of the word topic to also mean category.

28.   Applicant argues that the term 'topic' is not equivalent to the term 'category' (see at least pages 19, 20, 22 and 23 of Applicant's arguments). Examiner DOES NOT agree with this argument, particularly because Applicant supports this argument by <u>selecting</u> a single narrow definition from

among many definitions for 'category' and attempts to demonstrate how it is distinct from a <u>selected</u> single narrow definition of 'topic.' Examiner has reviewed several definitions of both terms and in many cases the word category is actually used in the definition of the word topic and vice versa. Despite Applicant's selective narrow interpretation of the terms in Applicant's arguments, Examiner applies the broadest reasonable interpretation in light of the specification to all terms used in the claims (see MPEP § 2111). Applicant fails to narrowly define 'category' in the disclosure, and likewise Dean fails to narrowly define 'topic.' Therefore a reasonably broad interpretation of these terms is appropriate and Applicant's argument attempting to distinguish and narrowly define the terms is inadequate.

29.   Applicant also asserts that Dean does not disclose "(2) an advertisement data searching unit configured for searching the advertisement database for advertisement data <u>corresponding to the maintained category related to the content to be displayed to a user</u>" (see page 21 of Applicant's amendment see also the mirror arguments for independent method claim 12 at page 22). Again Applicant focuses on non-functional descriptive material which is not given patentable weight. As shown in the rejections above, Dean discloses a component that retrieves relevant advertisements from the advertisement database and it determines the relevance of the advertisements based on the topics of those advertisements. Dean discloses retrieving advertisements that correspond to the target documents. For the reasons discussed above, Examiner <u>disagrees</u> with Applicants contention that Dean does not disclose categories and that the "category" of the claim is not equivalent to the "topic" of Dean's disclosure.

30.   Applicant argues that because of the alleged deficiencies in the teachings of Dean, Dean does not anticipate Applicant's claims. Applicant further argues that the 103 rejections are inadequate solely because of the deficiencies of the Dean reference. Examiner rebutted Applicant's assertions and arguments regarding the supposed deficiencies of Dean above. Therefore Examiner maintains that the cited Dean reference anticipates Applicant's claims as shown in the rejections above and further adequately presents a factual basis for the 103 rejections above.

Conclusion

31.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

32.   A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action.   In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action.   In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

33.   Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923.** The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724.**

34.   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

35.   Any response to this action should be mailed to:

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Commissioner of Patents and Trademarks

P.O. Box 1450, Alexandria, VA 22313-1450

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or faxed to **571-273-8300.**

36.   Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window:**

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Randolph Building

401 Dulany Street

Alexandria, VA 22314.

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/Nathan C Uber/ Examiner, Art Unit 3622
21 December 2008

/Arthur Duran/
Primary Examiner, Art Unit 3622